

Comments received from Members on Madras High Court Judgement

Muhammed Aslam Sharief.....	2
Alankar kirpekar.....	4
Anitha Chigurupati.....	4
Suneet Sabale.....	5
Maninder Kaur.....	6
Raguraman K.....	7
MP Bhatnagar	9

Muhammed Aslam Sharief

Herebelow are some points that crossed my mind as I read through the judgement which deserves to be appealed against on the following among other grounds.

Please acknowledge receipt and right back to me with your concurrence/ opinion on the following;

1. The honourable judge has erred in interpreting the amendment in the Act requiring Advocates to take the Patent Agent exam as discriminatory;- Had the Act required Advocates alone to take the PA Exam and not mandated science or engineering graduates to take the same exam, it would have constituted (class) discrimination as alleged. However, the impugned amendment to the Patents Act requires both Advocates as well as Science and Engineering graduates to take a common exam which puts to test their respective (a) proficiency in interpreting and describing scientific and technical aspects of cutting edge inventions and (b) competence in interpretation and application of patent law.

2. It is an undisputed fact that Patent Agents who are not Advocates, are anyways prohibited from contesting patent related cases at the District courts and High courts even though they are qualified (in interpretation and application of Patent Law and related drafting) by the impugned PA Exam. This is because litigation in these forums is more legal than technical, in nature and scope.

3. So points 1 and 2 above strike a perfect balance of reasonableness and equity between Patent Agents and Advocates.

4. Since patent documents are techno-legal in nature and scope, a unique blend of professionals from two distinct domains (Law and Technology) are required to serve their purpose. If the argument that all advocates are already equally qualified and efficient - is valid, then all advocates (or at least 95% of Advocates) who had so far appeared for the Patent Agent exam should have passed the exam with flying colours. A statistical review of the number of BL/LLB graduates who appeared and cleared the exam will prove whether or not this argument is sustainable. The Patent Office may provide relevant statistics to substantiate this (counter)-argument

5. The Language for drafting Patent Specifications and other documents in India is English or Hindi and needs to be of international standards in grammar, cogency, unambiguous

explanation and enablement; and which is addressed to a person skilled in the relevant Technical Art, and is not addressed to the Legal fraternity or to a Judicial officer. However, several Law Universities including Law College Chennai, do not mandate the use of English or Hindi in the BL/LLB qualifying exam. In fact even a Law student enrolled in the English Medium course of Law can answer the paper in the regional language Tamil to clear the exam.

The impugned judgment of the learned High Court judge has not paid due heed to this aspect, which would directly affect the quality of description of an invention and thereby its chances of obtaining a grant, among other issues.

6. All advocates in India are not too good in drafting especially Technical subject matter in English, to meet international standards. This is especially because no Law course in any law college in the country today perhaps, provides focused professional training in drafting of Technical specifications describing novel and inventive aspects of cutting edge inventions.

7. It is an industry practice to hire Patent Agents holding science/Engg degrees in the specific field relevant to the invention, to draft specifications etc., rather than hiring just any Patent Agent.

8. Going by the honourable judge's rationale, if a BL/LLB graduate is adept in satisfying the requirements of domains not directly related to law (such as science and technology), then BL/LLB should be the highest of qualifications, whereby even ML, M.Phil or Ph.D seem infructuous; and a BL/LLB graduate should be even competent to teach science and engineering subjects in colleges?!

9. The requirement of the impugned amendment is consistent with the most equitable and globally time-tested system of selection process wherein, for admission to professional, arts or science courses/careers, a Common Entrance Exam is conducted so as to evaluate candidates from different domains, fields and experience levels. Examples of this include, International exams like GRE, TOEFEL, GMAT as well as national level exams such as CAT or TANCET for MBA and Engineering courses or even the UPSC and SSC exams etc.,

In view of the above an appeal may please be filed against the honourable judge's order to ensure that even Advocates must (a) have undergone a science or engineering degree course, (b) pass the Patent Agent Exam.

Thanks and regards,

Muhammed Aslam Sharief

IN-PA-1951

Alankar kirpekar

Dear PAAI Team,

I feel that this is appropriate and this takes us back to 2005. I feel that the examination shall not be applicable to lawyers having technical or science background. I am with this order. In my opinion technical background plus advocate shall be made compulsory. As it is found that even only technical persons do not understand the intricacies of law.

It is apparent that the Union of India has not represented the case properly. The necessity of a science background was introduced and also the examination was started only with the sole motive that those who have knowledge of science and technology shall perform the important function of drafting the Complete Specification. Though it is accepted that Patent is a technical legal field but drafting of complete specification is something that has more technical involvement which a non-technical person would find it difficult to understand. This fact is also accepted by all countries. Hence even abroad to practice in the Patent field one needs to undergo examination. This fact should be necessary to bring on record.

One more important issue is that except drafting and filing of Patent, Advocates can do every act under Patent Act, 1970.

Alankar kirpekar

Anitha Chigurupati

I am Anitha Ponnekanti working as IP professional at a chemical company.

I have 10 yrs exp in practicing patents, be it patent search, analysis, drafting or prosecution.

I would like to present my comments on recent decision related to constitutional validity of section 126.

Indian Patent office job is to grant patents for inventions. Inventions involve technical expertise. Inventors draft their application describing the details of invention.

A lawyer doesn't understand the intricacies of invention. If patent application is not properly drafted, it will not lead to an effective patent. Understanding the scientific terms in invention cannot be learned like any sections or rules in law. So lawyers cannot do justice to the inventor.

Patent agents are those who are having knowledge of law and science.

Personally we work with lawyers in our legal team.

They understand the legal terms and functions of the patent office by their experience. But when it comes to drafting only an expert in the field is called for. Even they sit with scientist, IP professionals and work on to prepare a good draft.

According to me, any act is made to enable the activities of a govt office to proceed smoothly and as per law. Similarly patent agents are qualified to practice before the patent office.

If any other views, please welcome.

Thank you for giving me an opportunity to put my views.

Regards,

Anitha.

Suneet Sabale

Dear All,

As per my understanding, there was no strong counter argument, which would have reflected importance of science/technical education.

There it is mandatory to oppose this judgment in supreme court with the facts and importance of science education.

If the case was fought on the bases of Article, 14, 19(1g) and 21, then I think every qualifying exam in place as on date is against article 19-1g of Indian Constitution.

Therefore, every person should be allowed to work as a doctor, adv., etc. but that is not the case. According to Article -14 "*Prohibition of discrimination on grounds of religion, race, caste, sex or place of birth*", but education is exempted. If the lawyers are allowed to draft a case and plead in the court of law, then why not technical person who has a skill of interpreting the technology not allowed to draft a patent application. If a lawyer without understand the technology, he can draft, then a technical person without understanding the legality he can as well draft a patent application.

Basically, there was no counter argument, to emphasis importance of technical knowledge. This seems to be an onsidess battle.

- Suneet Sabale

Maninder Kaur

Assuming that all that is being said about this judgement has even half of truth in it, it will be really unfortunate. It throws out any value or purpose associated with becoming a Patent Agent. This happens at a time when Advocates themselves are being asked to take the BCI exam to allow them to appear before the courts. Assuming that now Advocates can file applications or prosecute applications on behalf of clients, then we now have advocates who fail to practice even practice before the court but can file and prosecute patent applications of which they have no clue!! If this be the case, then all professional examinations are meaningless.

And that comment/argument about inventors not requiring any qualifications so it should not be mandatory for agents to have qualifications is almost akin to saying that since a patient does not need to have a qualification, a doctor also should not. It will be really unfortunate if rather than progressing forward and improving the quality of professionals in the field, we are moving backwards. wish I am wrong.

- Maninder Kaur

Raguraman K

I entirely disagree with the Chennai High Court's decision. One of the main arguments from the petitioner (and accepted by the Court) is that the functioning of an advocate (drafting, preparing the case legally, filing and advancing arguments) is similar to the functioning of Patent agents (according to Section 127, patents act) and therefore an advocate can also perform the duties of the patent agent. I am also amused by a statement in the judgement that a lawyer is a social engineer and the legal studies is also a science, and therefore a lawyer should not be discriminated in the patent practice.

However, I think the Court erred by superficially comparing the duties of the Patent agent and an advocate. If we were to look into the details of the job of the patent agent and analyze whether an advocate can perform the duties of a patent agent. I think things will be more clearer to rationally determine whether an advocate can register as a patent agent or NOT. Interacting with an inventor and understanding his invention requires lot of technical skills from a patent agent. One of the fundamental duties of a patent agent is to advise an inventor/applicant on whether the invention will pass the novelty requirement of the Patents act and for that requirement, a patent agent has to perform a prior art search, which requires reading/reviewing lots of documents ranging from a patent application to a white paper to an IEEE document...etc (Many people would concur with me that IEEE documents are very complex and highly technical). I think a lawyer without a basic understanding of technical subjects will definitely have a problem in performing a prior art search and working with the inventors to identify the scope of the claims. Not only this, the patent agent also should draft claims in such a manner so that a competitor cannot get around the claims - this requires ability to understand and appreciate the existing technologies related to the current inventor

and further an ability to forecast the technology. All this requires deeper understanding of the invention and the underlying technology of the subject matter.

Based on my experience, inventors expect the drafter of the patent application to have prior knowledge of the technology/subject matter in question. Further, we cannot expect the inventors to spend all their time in explaining each and every word/term associated with their invention. If an inventor were to employ a lawyer without science/engineering background, most of the time would be spent in teaching the invention to a lawyer, rather than the preparation of the application itself. I think the court also erred in interpreting the meaning of the term "APPLICATION". It looks like the term "Application" was interpreted in a general sense to mean a template form filled with known/fixed information. However, Patent APPLICATION is not a normal application that people (or for that matter Lawyers) prepare every day, it is a highly technical document filled with information describing a technology/science sought to be protected in accordance with the requirements of the patents act. This is the reason why Patent Office also employs people (Examiners) with science/engineering background to examine the patentability of the case as against employing a person with a pure law background. Patent agent further works with inventors/applicant's in responding the rejections outlined in the Office action. Although, all the non-substantive objections can be easily addressed by a person with non-science/technology background, the matter requiring the novelty and inventive step rejections are fairly complex and it requires the patent agent to review the references and the claims and judiciously use any comments received from the inventor to draft technical and legal (which may also be technical in nature) arguments which may not be all straight forward to a person with non-science/technology background.

In my opinion, at least the work related to preparation of patent specification and the response to the Office Action requires a person who has a good prior understanding of the technology in question and basic understanding of the patent laws and rules in question. However, a lawyer with a non-science/technology background will have difficulty in fairly understanding the technology and so, will not be able to draft a quality patent application which can practically be enforced for the duration of the patent. A lawyer without a science/background can at best do the paper works necessary for filing an application, but not an application itself. If we want to have a robust patent system in India, we cannot have such patent agents who only does the paper works for filing and responding, rather a patent agent who can better appreciate the science and technology underlying the invention sought to be protected. Therefore, there is no rationale in the argument that the activities of a patent agent are similar to the activities of an advocate. This leads to the logical conclusion that the a lawyer without a science/engineering background is not qualified to perform the substantial activities of a patent agent.

- Raguraman K

MP Bhatnagar

Dear Sir,

It is really very interesting and befitting to file an appeal against the Honourable Chennai High Court Decision. The drafting of the patent needs not only the intricacy of Patent law but also a sound knowledge of Science and Technology. I am a Person who holds a degree in engineering with nearly 26 years of experience in as a Person in charge of licensing in different technology developed in India. Thus having in depth knowledge of Various subjects. I had also worked as a Visiting prof. in MAX Planck Institute for International Patents, Trade-Mark and Copy rights in Munich Germany in 1982 and 1989. I also worked as an examiner in the Patent Office for 12 Years but still after being in the field of Patent for more than 53 years and having wide exposure to the various patent laws of the world not feeling competent enough to draft the Patent specification in completed drug Patent Applications. I remember very well that One of my colleague who is a Patent Agent and an Advocate claimed a composition by typing the formula in the reverse directions due to photo coping the claims. Another instance where the applicant suffered a huge loss due to drafting of the claims by a reputed Advocate and also a Patent Agent. The Applicants were served a legal notice by one of the leading multi-national in UK but his product was not infringing the Patent. I gave the opinion in that matter and the multinational has to withdraw the notice. Unfortunately the Invention was lying in the gear arrangement arrange in typical fashion which was not claimed so the party could not stopped others coping his invention. The fate of the inventor lies in the hands of the Patent Agent as what you claimed is your right and not what you describe. In India the Claim 1 is the heart of the Invention. According to me, you may take the various rules and regulation to become entitled to be Patent Agent/Patent Attorney entitled to appear before EPO/USPTO the latest to enter the IPR is China and you may also take advantage of there rule and regulations to become entitled to be the Patent Agent/ Attorney. The loser is the applicant/ Inventor and not the advocate or the incompetent Patent Agent. The Applicant should not suffered at the hand of the personal dealing with his invention. The judgement is not going to harm the judiciary but only the Inventors whose hard labour will be destroyed at the end of Patent handling person.

Fortunately/ unfortunately, most of the Patent Attorneys are surviving on the Patent Applications filed by multinational and drafted abroad. We are only acting as a Post Office. I remember one case of one of my colleague when he was discussing the case with the controller, wherein, the controller directed him to delete the word at least from claim 1 as Indian Patent Office is not allowing the word at least which the Patent Agent deleted as he has a shallow knowledge of Chemistry and has not cared to read the complete specification. By deleting the word at least the Invention will not reside in claim 1 and claim 1 will be claiming the Invention already known in the art as described and explained in the specification. After lot of efforts and persuasion the controller agreed in the interest of the applicant to retain the word at least and the invention was saved. The Drafting of the Patent especially the claims needs the complete understanding of the Technology. Why not it be made compulsory to disclose the basic qualification of the person who will be handling the case then the choice will be left to the applicant. All the qualification of the Patent Agent/ Attorney should be published and be made available to the applicant/ Inventor. Then the position will not come that the inventor will give his Invention for protection to the non-technical person, and even to a technical person having no knowledge of his subject. The Judgement is biased towards the legal fraternity and against the interest of the Inventor/Applicant. Who might have developed the Invention after spending millions of dollars or Rupees. There is lot to be talked but it is requested that before you file an appeal home work should be done properly.

I am at your disposal for any further input but please remember that the present qualification and the present way of Patent Agent Examination is under question. I remember that some of the Ex- patent controllers who have been in the viva were not having proper knowledge themselves. As they never worked throughout their life regarding learning the Patent law besides being technically weak background.

What you want to say about this?

With regards

Yours faithfully,

MP Bhatnagar